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In the Supreme Court

OF THE

United States

OCTOBER TERM, 1997

BECTON DICKINSON VASCULAR ACCESS, INC.
Petitioner,

v.

CRITIKON, INC.,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

REPLY TO OPPOSITION

EDWARD F. MULLOWNEY
(Counsel of Record)
FISH & NEAVE
525 University Avenue
Palo Alto, California 94301
(650) 617-4000
Counsel for Petitioner

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Pacific Financial Printing, Menlo Park, CA (650) 328-1500

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Fed.R.Civ.P. 52(a) 3,4

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I. The Viability Of *In re Glass* Should Be Settled By This Court

The District Court held that prior art — published *after* an inventor files his or her patent application — may be relied upon to enable claims not supported by what was disclosed in the inventor's application (41a). That holding directly conflicts with *In re Glass,* 492 F.2d 1228, 1232 (CCPA 1974) (claims must be fully enabled when an application is filed) and signals a significant change in patent law. The Federal Circuit's affirmance, given its exclusive jurisdiction over appeals in all patent cases (*Cardinal Chem. Co.* v. *Morton Int'l Inc.,* 508 U.S. 83, 89, 113 S.Ct. 1967, 1971 (1993)), adds substantial weight to that change.

In opposing this Court's review of that change, Respondent contends that information determined to be prior art against a patent is by definition "known to persons skilled in the art" as of the filing date of that patent (Opp at 2-3).[1] That contention is absolutely false. 35 U.S.C. § 102(e); *In re Glass, supra,* 492 F.2d at 1231 ("contents of a patent application which may be available as 'prior art' under § 102(e) may not have been known to anyone other than the inventor, his attorney, and the Patent Office Examiner ... until it issued as a patent").

Like the four prior art patents at issue in *In re Glass,* the Lemieux patent had not been published when Dombrowski filed his patent application. Under the rule of *In re Glass,* the District Court should not have relied on Lemieux to enable Dombrowski's otherwise unsupported claims.[2] Contrary to Respondent's assertions, this question does not present a "misapplication of a properly stated rule of law" nor a case where "both lower courts made erroneous fact findings" (Opp at 11-12). A rule of statutory construction that has long defined the balance between 35 U.S.C. §§ 112, 131 and 132

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[1] "[T]he parties stipulated that the Lemieux patent was 'prior art' to the Dombrowski patent. (46a). Thus, by stipulation, the parties agreed that the technique ... disclosed in Lemieux ... was known to persons skilled in the art before Dombrowski" (Opp at 2-3).

[2] Respondent's claim that "another patent predating Dombrowski" bolsters the District Court's conclusion based on Lemieux (Opp at 3-4 and 11) is pure revisionism. If Respondent really believed that Dombrowski's "tetherless" claims were enabled by other prior art, it would have so argued at trial. It did not.

Respondent's other claim, that Petitioner's expert witness "freely admitted that the Dombrowski safety catheter did not require the use of a tether" (*id.* at 11) is also false. Respondent's hypothetical question, that Dombrowski's invention could be made to work "without a long tether ... *if* you used the engaging means similar to Mr. Lemieux" (*id.* at 3; emphasis added), shows nothing more than that Dombrowski's invention requires either a tether — or Lemieux's disclosure. For precisely that reason, Dombrowski's "tetherless" claims are not enabled under 35 U.S.C. § 112.

has been disregarded with significant consequences for the federal patent system. The viability of that rule compels a review on a writ of certiorari.

II. "More Than A Coincidence" Is Not The Standard Of Review Required By Rule 52(a)

Respondent's opposition to Petitioner's second question is based on the false premise that the District Court "rejected the 'independent development story' " (Opp at 12 and 13) established by Petitioner at trial. Therefore, concludes Respondent, the Federal Circuit could not have violated Rule 52(a), Fed.R.Civ.P., by disregarding the District Court's opportunity to hear trial testimony and by basing its contrary finding on conjecture.

Respondent's premise is refuted by the District Court's opinion:

> the Court finds that the evidence that [Respondent] relies upon in support of a finding of willfulness is rebutted by other evidence adduced at trail by [Petitioner] including some opinions of counsel.
>
> Moreover, [Petitioner] argues strenuously that, despite the ultimate fact that its accused device ... may infringe the [patents-in-suit], the device was independently developed. ... (41a; record cite omitted).[3]

The District Court heard Respondent's copying argument and weighed it against the consistent testimony of the engineers responsible for designing Petitioner's catheter and against the objective evidence that corroborated their testimony. Without the District Court's advantage of assessing the credibility of those witnesses, and without identifying any contradictory evidence, the Federal Circuit concluded

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[3] The District Court's observation that Petitioner was "less cautious that it ordinarily might have been in assessing its positions vis-a-vis [the patents-in-suit]" (42a), in no way supports Respondent's claim that the District Court "believed that the facts pointed towards copying, not towards independent development" (Opp at 4).

that Petitioner's infringement must be *"more than a coincidence"* (15a; emphasis added). The Federal Circuit opinion is silent on what features of those patents were supposedly "adopted"[4] and is wrong about when Petitioner "became aware" of the patents-in-suit.[5]

Petitioner's second question presented is not, as Respondent suggests, a "poorly disguised and improper attempt to seek review of fact findings" (Opp at 14). The Federal Circuit reversed the District Court based on no more than unsupported conjecture that Petitioner's engineers "adopted" unspecified "features" from Respondent's patents. That serious disregard "of the trial judge's position to make determinations of credibility" (*Anderson* v. *City of Bessemer City,* 470 U.S. 564, 565, 105 S.Ct. 1504 (1985)) compels review on a writ of certiorari.

III. The Federal Circuit Could Not Have Reviewed The June 11, 1991 Opinion Of Petitioner's Counsel

In reversing the District Court's finding that Petitioner did not willfully infringe the patents-in-suit, the Federal Circuit also made a the subsidiary finding that the legal advice relied upon by Petitioner was "superficial and conclusory"

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[4] Contrary to Respondent's hyperbole, the Federal Circuit did not hold that Petitioner "specifically copied key features disclosed in the Lemieux and Dombrowski patents" (Opp at 6). The Federal Circuit's only comment concerning any "feature" of Petitioner's catheter was that Petitioner "apparently shifted to a long nose design" (14a). The Federal Circuit did not find that Petitioner copied that feature from the patents-in-suit and neither the District Court nor the Federal Circuit found that the "nose-length" of Petitioner's catheter had anything to do with infringement (*see infra* at 5).

[5] Contrary to the Federal Circuit's conclusion that Petitioner managed to commercialize its design "soon after it became aware" of the patents-in-suit (15a), it is undisputed that Dr. Dombrowski (co-inventor of one of the patents-in-suit) disclosed his invention to Petitioner in September 1988 — almost *three years* before Petitioner finalized the accused design in the summer of 1991. The Federal Circuit's *de novo* conjecture concerning the publication of the patents-in-suit in 1990 has no basis in fact.

(14a). That finding is not only a misapplication of the standard for determining the competence and reliability of such advice, it is so demonstrably incorrect that it could not have been based on a review of the "entire evidence" (*United States* v. *United States Gypsum Co.*, 333 U.S. 364, 365, 68 S.Ct. 525 (1948)) and thus fails to comply with Rule 52(a), Fed.R.Civ.P.

Respondent's opposition to this Court's review of that error boils down to a two-point explanation of how the Federal Circuit could have considered the June 11, 1991 opinion of Petitioner's counsel (56a-66a) to be superficial and conclusory. First, Respondent spins the conspiracy theory that the competence and objective reliability of that opinion does not matter because "petitioner's management knew all along that its . . . design was 'patent infringing'" (Opp at 14-15). Fatal to that argument is the fact that neither the District Court nor the Federal Circuit ever even discussed Respondent's so-called evidence of a "scheme to infringe" (*id.*), let alone found such a conspiracy.

Second, Respondent attempts to attack the substance of that opinion by arguing that it "is directed to the wrong safety catheter" (*Id.* at 15). As the Federal Circuit observed, that opinion relates to "the short-nosed" version of Petitioner's catheter (14a). But neither the District Court nor the Federal Circuit found that "nose-length" of petitioner's device had anything to do with infringement. Thus the Federal Circuit's observation that "[s]ignificant design changes, *in most instances,* would require a new opinion of counsel" (*id.;* emphasis added), does not apply in *this* instance.

Respondent's own unsupported and self-serving characterization of Mr. Kammer's opinion as conclusory fails to provide any more explanation for the Federal Circuit's *de novo* finding than can be gleaned from the Federal Circuit's opinion.

IV. Conclusion

For the reasons set forth above, as well as for those set forth in the petition, Petitioner's request for review on a writ of certiorari should be granted.

March 20, 1998

Respectfully submitted,

Edward F. Mullowney
FISH & NEAVE
525 University Avenue
Palo Alto, California 94301

(650) 617-4000

Counsel of Record for Petitioner
Becton Dickinson Vascular Access, Inc.